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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/542,670	04/04/2000	Alex Urich	155696-0024	5579

7590

05/11/2004

Ben J Yorks  
Irell & Manella LLP  
Suite 400  
840 Newport Center Drive  
Newport Beach, CA 92660

EXAMINER

NGUYEN, VI X

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/542,670

Applicant(s)

URICH ET AL.

Examiner

Victor X Nguyen

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-48 and 56-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-48 and 56-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Art Unit: 3731

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/19/2004 has been entered.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35-36, 38-39, 41-43, 46, 56-57 and 59-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Cimino.

3. Regarding claims 35, 38, 41, 45, 56 and 59, Cimino discloses in figs. 1-2, a console (11) that is coupled to a hand piece (12) which has a tip (14). A control circuit (16) that can be coupled to the tip that has generation of pulse packet which are separated by pause periods as best seen on fig. 2b to prevent denaturing of tissue. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case the surgical device of Cimino would have been capable of performing the use as claimed. In

Art Unit: 3731

a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claims 39, 42, 46, 57 and 60, Cimino discloses the packet has a time duration less than about 1 milliseconds (see col. 4, lines 61-66).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35, 38, 41, 44-45, 48, 56, 59 and 62 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kellogg et al (5,897,569) in view of Klopotek (5,196,006).

Regarding claims 35, 38, 41, 45, 56 and 59, Kellogg et al show in figures 1, 4, 5 and abstract, col. 3 lines 19-45, a console (30) can be coupled to a hand piece (80) that has a reciprocating tip (88); wherein a control circuit (36) that is coupled to the console (30) and generates packet of pulses. However, Kellogg et al do not disclose wherein the packet is separated by a pause period of no pulses.

Klopotek et al teach the packet is separated by a pause period of no pulses (fig. 5b, and see col. 8, lines 44-67).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Kellogg et al by adding the packet is separated by a pause

Art Unit: 3731

period of no pulses as taught by Klopotek et al in order to cut tissue with a minimize of heat.

Regarding claims 44, 48 and 62 Kellogg et al disclose the temperature does not exceed 45 degrees centigrade (col. 3 lines 29-34).

Claims 35, 37-38, 40-41, 45, 47, 56, 58-59 and 61 are rejected under 35 U.S.C 103 (a) as being unpatentable over Kellogg et al (5,897,569) in view of Cimino(6,027,515).

Regarding claims 35, 37-38, 40-41, 45, 47, 56, 58-59 and 61, Kellogg et al disclose the invention substantially as claimed. However, Kellogg et al do not disclose the pause period has a time duration between 3.5-50 millisecond. Cimino teaches the pause period has a time duration between 3.5-50 millisecond (col. 8 lines 16-24).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Kellogg et al by adding the pause period has a time duration between 3.5-50 millisecond as taught by Cimino in order to minimize the substantial amount of heat at the cutting tip and improve the reliability of the device.

#### ***Response to Amendment***

5. Applicant's arguments filed 3/19/2004 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 35, 38, 41, 45, 56 and 59 have been considered but are moot in view of the new ground(s) of rejection. Applicant is asked to please refer to the modified prior art rejection above wherein examiner addresses applicant's concerns regarding prior art rejections. For example, Cimino discloses in figs. 1-2, a console (11) that is coupled to a hand piece (12) which has a tip (14). A control circuit (16) that can be coupled to the tip that has generation of pulse packet which are separated by pause periods as best seen on

Art Unit: 3731

fig. 2b to prevent denaturing of tissue. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case the surgical device of Cimino would have been capable of performing the use as claimed. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898.

The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn *VN*  
May 3, 2004

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700